

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.116 and in light of the remarks which follow, are respectfully requested.

By the above amendments, claim 1 has been amended for clarification purposes, and now recites colored resin particles comprising core/shell particles, the core/shell particles comprising: a core comprising a coloring component, wherein the coloring component comprises a pigment subjected to a surface treatment; and a shell layer comprising a resin component coating around the core, wherein the shell layer is obtained by dispersion polymerization. Support for such amendment can be found in the specification at least from page 11, lines 19-23, taken in connection with page 25, lines 13-18. Claim 1 has also been amended for readability purposes. Entry of the foregoing amendments is proper at least because such amendments are effective to place the application either in condition for allowance or in better form for appeal. See M.P.E.P. §714.12.

In the Official Action, claims 1, 3, 10 and 11 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0077383 (*Takao et al.*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Independent claim 1 is directed to an oil based ink composition for inkjet printer comprising colored resin particles comprising core/shell particles, the core/shell particles comprising: a core comprising a coloring component, wherein the coloring component comprises a pigment subjected to a surface treatment; and a shell layer comprising a resin component coating around the core, wherein the shell layer is obtained by dispersion polymerization of a monofunctional polymerizable monomer (A) and a monofunctional polymerizable monomer (B) copolymerizable with the monomer (A) having a substituent

containing a silicon atom and/or a fluorine atom, with fine particles of the coloring component, which are dispersed in a non-aqueous solvent having a dielectric constant of from 1.5 to 20 and a surface tension of from 15 to 60 mN/m at 25 °C, as seed particles, in the presence of a dispersion stabilizer (P) soluble in the non-aqueous solvent and a polymerization initiator.

Takao et al does not disclose each feature recited in claim 1, and as such fails to constitute an anticipation of such claim. For example, *Takao et al* does not disclose colored resin particles comprising core/shell particles, the core/shell particles comprising: a core comprising a coloring component, wherein the coloring component comprises a pigment subjected to a surface treatment; and a shell layer comprising a resin component coating around the core, as is now recited in claim 1.

That is, claim 1 now recites core/shell particles comprising (1) a core comprising a coloring component which in turn comprises a pigment subjected to a surface treatment, and (2) a shell layer comprising a resin component coating around the core. The Patent Office has taken the position that *Takao et al*'s disclosure of the adsorption of the silicone graft polymer to the pigment corresponds to the claimed surface treatment of the pigment (Official Action at page 4). However, even if the disclosed adsorption of the silicone graft polymer to the pigment could properly be considered a surface treatment of the pigment, *Takao et al* nevertheless fails to disclose both a pigment subjected to a surface treatment and a shell layer around the core, as recited in claim 1. *Takao et al* simply has no disclosure of both such features, and consequently fails to constitute an anticipation of claim 1.

Accordingly, for at least the above reasons, withdrawal of the above §102(b) rejection is respectfully requested.

Claims 1, 3, 10 and 11 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,197,847 (*Kato et al*) in view of European Patent Document No. 1 205 815 (*EP '815*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

As discussed above, claim 1 has been amended to explicitly recite the core/shell structure of the colored resin particles. For example, claim 1 now recites that the colored resin particles comprise core/shell particles comprising: a core comprising a coloring component, wherein the coloring component comprises a pigment subjected to a surface treatment; and a shell layer comprising a resin component coating around the core.

Applicants respectfully submit that no motivation or suggestion exists to combine *Kato et al* and *EP '815* to arrive at the claimed colored resin particles in the manner suggested by the Patent Office. In this regard, it is noted that in support of its rationale, the Patent Office has asserted the following at page 5 of the Official Action:

While there is no disclosure in EP 1205815 of colored particles as presently claimed, note that EP 1205815 is used as [a] teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention. . . Rather this reference teaches a certain concept, namely the use of pigment subjected to surface treatment in ink jet inks improves the dispersion stability and charge characteristics of the ink . . . [Emphasis added.]

Thus, the Patent Office has relied on *EP '815* for disclosing that the use of a pigment subjected to a surface treatment results in the improvement of characteristics of the ink product.

In view of various disclosures of *EP '815*, it is apparent that the surface treatment of the colorant particles thereof pertains to the outermost surface of such colorant particles in the final ink product (paragraphs 0012, 0046 and 0054). Thus, quite clearly, the various advantages associated with employing the surface treatment disclosed by *EP '815*, relate to

the use of particles in which the treated surface constitutes the outermost surface of such particles in the final ink product. However, the Patent Office has relied on *EP '815* for providing motivation to modify *Kato et al* by employing a surface treatment of the coloring material itself, i.e., a surface that is not the outermost surface of the particles disclosed by *Kato et al.*¹ Clearly, one of ordinary skill in the art would not have been motivated to treat the surface of the coloring material of *Kato et al* with the reasonable expectation that such treatment would result in attaining the advantages discussed in *EP '815*, since such advantages relate to particles wherein the treated surface constitutes the outermost surface of the particles in the final ink product.

Simply put, no motivation or suggestion exists to modify *Kato et al* in view of *EP '815* in the manner suggested by the Patent Office. Accordingly, for at least the above reasons, withdrawal of the above §103(a) rejection is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

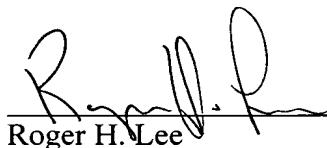
¹ The Official Action at page 5 states that "Kato et al. already disclose oil-based ink comprising resin particles containing coloring material wherein the resin particles have mean particle size of 0.08 μ m to 0.8 μ m. However, there is no disclosure in Kato et al. that the coloring material is a pigment that is subjected to surface treatment. This is why Kato et al. is used in combination with EP 1205815." Thus, the Patent Office has relied on *EP '815* for providing motivation to modify *Kato et al* by employing a surface treatment of the coloring material itself.

If the Examiner has any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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